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EXAMINER

HENDRICKS, KEITH D

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 09/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/929,066	Applicant(s) ITO ET AL.	
	Examiner Keith Hendricks	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 27 May 2003.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-4, 7 and 8 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-4, 7 and 8 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102 & 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

i) Claims 1-4 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Qian (CN 1123833). The reference and rejection are taken as cited in a previous Office action.

ii) Claims 1-4 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kaneko (JP 57-125669). The reference and rejection are taken as cited in a previous Office action.

Applicant's arguments filed May 27, 2003, have been fully considered but they are not persuasive. Addressing both references simultaneously at page 6 of the response, applicants state that such "fermentation of sugars and starches to produce alcohol occurs generally under an anaerobic environment, i.e. with little or no oxygen", and thus the reference does not inherently disclose a fermentation step while supplying oxygen as presently claimed. This is not deemed persuasive for the reasons of record.

In response to applicants' arguments, a recitation of the steps of making the claimed invention within a *product claim*, must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Absent any clear and

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convincing evidence and/or arguments to the contrary, the claimed *product* is anticipated by the reference. Applicant has shown no patentable difference in the claimed products, and further has shown no reason why the disclosed method of the reference would not have produced the claimed product. If the same starting materials are utilized and the general method disclosed is the same as that of the instant claims (which are also generally recited), then the product must be taken to be the same. Applicants' statements with regard to the aerobic versus anaerobic fermentation are not specific to any particular type of yeast, and thus are not deemed persuasive. Similarly, the claims are not drawn to any specific type of yeast, and thus broad statements regarding the use of aerobic versus anaerobic fermentation conditions are not deemed persuasive.

As previously stated, note that the instant specification discloses at page 4, lines 3-5, that "suitable yeast includes any yeast belonging to *Saccharomyces*, such as beer yeast, wine yeast, sake yeast, or baker's yeast". Such yeast (a) produce alcohol by fermenting sugars and starches, and (b) ferment aerobically, as well. Thus, applicants' statements that such fermentation generally occurs under an anaerobic environment, are not well supported. Further, applicants' claims do not specify a means by which oxygen is "supplied." Given this, alternatively, the inclusion of a step to agitate the fermenting mixture in order to supply oxygen to the living yeast organisms, would have been obvious to one of ordinary skill in the art, based upon the teachings of the reference, as well as the knowledge of the state of the art at the time the invention was made, in order to facilitate the fermentation, and maintain the viability of the yeast.

iii) Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Hattori et al. (JP 58-152,458).

Hattori et al. disclose a method for fermenting soya milk, and the soya milk produced therefrom. As stated in the English-language abstract, the method comprises the steps of soaking and boiling soybeans, and then cooling. The beans are ground with water and boiled again, and the "suspended materials are removed from the extract to obtain a soya milk", which is cooled and concentrated under reduced pressure. "Yeasts belonging to *Saccharomyces* genus are inoculated in the cooled soya milk, and fermented at rest or under aeration and agitation. The fermentation liquid is heated to sterilize" and obtain the resulting composition. Thus, the claimed invention is anticipated by the reference.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 7-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 (or those currently pending) of copending Application No. 09/929,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions produced by the same method, regardless of the preamble label of intended use of the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed May 27, 2003, have been fully considered but they are not persuasive. At page 7 of the response, applicants state that "cosmetics and beverages belong to two different categories of subject matter", and that "it would not have been obvious to a person of ordinary skill in the art that a component of a cosmetic may be used in a beverage." This is not deemed persuasive for the reasons of record. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a component of a cosmetic") are not recited in the copending '064 claims, nor are limitations to specific beverage components recited in the instantly-rejected claims. There are no specifically-recited elements in either set of claims which would distinguish the two compositions, save for the artificial labeling of one composition as a "beverage" and another as a "cosmetic". For example, if both contain water and the superoxide scavenger, there are no distinguishing elements between the two compositions. Until particular components unique to cosmetics and/or beverages are recited in the claims, the two inventions overlap. Still further, if both sets of claims provided a general recitation to an additional "beverage component" (or a "cosmetic component"), this would not serve to further distinguish the claims.

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Claims 7-8 free of the prior art of record. The prior art of record does not teach or suggest the subsequent concentration and drying under reduced pressure of the fermented composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



KEITH HENDRICKS
PRIMARY EXAMINER